

Docket No.: 01-8001
(PATENT)**REMARKS****I. Introductory Comments**

As a preliminary matter, Applicants thank the Examiner for providing the Office Action and the references cited therein. In the Office Action: (1) claims 27, 35-37, 45, 46, 51, and 52 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,581,105 to Miloslavsky et al. (hereinafter "Miloslavsky"); and claims 28-34, 38-44, 49, and 50 were rejected under 35 U.S.C. §103(a) as being obvious over Miloslavsky in view of U.S. Patent No. 6,321,267 to Donaldson (hereinafter "Donaldson").

Applicants have amended independent claims 27, 37, 46, and 51 to further articulate novel aspects of the claims. Applicants believe that these claims as amended, as well as all their dependent claims (claims 28-36, 38-45, 47-50, and 52), are in condition for allowance. Therefore, it is respectfully requested that Examiner reconsider the currently pending claims (claims 27-52) for allowance.

II. Rejection of claims 27, 35-37, 45-48, 51, and 52 under 35 U.S.C. §102(e)

On page 3 of the Office Action, the Examiner rejected claims 27, 35-37, 45, 46, 51, and 52 under 35 U.S.C. §102(e) as being anticipated by Miloslavsky. Although not explicitly stated in the Office Action, it appears that the Examiner has also rejected claims 47-48 under 35 U.S.C. §102(e) as being anticipated by Miloslavsky. For purposes of this Amendment, Applicants assume that the Examiner intended to expressly reject claims 47-48 as being anticipated by Miloslavsky. All of these rejections are respectfully traversed.

A. Claims 27, 37, and 52

By this Amendment, independent claims 27, 37, and 51 have been amended to recite the claim limitation of breaking up an electronic mail message nested in the complaint. By being able to break up nested electronic mail messages, the claimed invention is able to robustly analyze the nested mail messages. For example, the claimed invention can parse and analyze components of unsolicited commercial emails that a complainant may have forwarded to a help desk as an attachment to a complaint (see paragraphs 11, 24, and 34-35 of the Specification). It is respectfully submitted that this claim limitation is not disclosed or taught in the prior art of record. Inasmuch as the Examiner interprets the email message taught in Miloslavsky to read on the complaint limitation recited in the claims (see page 3 of the Office Action), Miloslavsky does not teach the claim limitation of breaking up an electronic mail message nested in the complaint. For at least these reasons, claims 27, 37, 51,

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and their dependent claims (claims 28-36, 38-45, and 52) are in condition for allowance.

B. Claim 46

Independent claim 46 has been amended to recite the claim limitation of a message parser adapted to break a message nested in the complaint into a plurality of message components. This claim limitation is similar to the claim limitation discussed above in relation to claims 27, 37, and 52. Therefore, the same arguments apply equally in regards to claim 46, and Applicants respectfully submit that claim 46 and its dependent claims (claims 47-50) are in condition for allowance.

C. Dependent Claims are Patentably Distinguishable

Even though claims 28-36, 38-45, 47-50, and 52 depend from claims 27, 37, 47, and 51, Applicants assert that these claims also include independently patentable subject matter. Merely by way of example, Applicants respectfully submit that the Office Action has failed to establish anticipation against claims 35, 45, and 52. To establish anticipation, the Examiner must show that every element of a claim is found in a single prior art reference (MPEP 2131). The portions of Miloslavsky cited against claims 35 and 45 disclose the use of a URL to enable a browser to access a particular web page (col. 11, lines 17-27 and col. 12, lines 15-20) but do not disclose a URL that is extracted information as claimed. Similarly, the portion of Miloslavsky cited in the Office Action against claim 52 discloses use of IP addresses in the IPNT world but does not disclose an IP address to be an extracted specific field as claimed. The Office Action thus fails to establish anticipation against claims 35, 45, and 52, and for this reason, as well as by reason of their dependencies from allowable independent claims, these claims and their dependent claims (claim 36) are in condition for allowance.

III. Rejection of claims 28-34, 38-44, 49, and 50 under 35 U.S.C. §103(a)

On page 5 of the Office Action, the Examiner rejected claims 28-34, 38-44, 49, and 50 under 35 U.S.C. §103(a) as being obvious over Miloslavsky in view of Donaldson. The Examiner admits that Miloslavsky fails to teach the step of parsing to include locating a header (see Office Action, page 5). The Examiner then modifies Miloslavsky with Donaldson's teachings of locating a header message in order to reject email from unknown hosts. However, in addition to being patentable by virtue of being dependent from claims 27, 37, and 46 as discussed above, claims 28-34, 38-44, 49, and 50 recite limitations that are independently patentably distinct over the prior art of record. Thus, the Office Action fails to establish a *prima facie* case of obviousness against those claims because the cited references

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do not teach or suggest every claim limitation as is required to establish a *prima facie* case of obviousness (see MPEP 2143). Representative examples of patentable subject matter from various of the rejected dependent claims follow.

A. Claims 30 and 39

With respect to claims 30 and 39, the Examiner cites col. 2, lines 37-41 of Donaldson (page 6 of the Office Action), which discloses removing a message from a sending host device once a transmission of the message is complete. This teaching of Donaldson does not teach the claim limitation of the normalizing step including the step of removing at least one character from the header based on the header keyword. Removing a message from the queue of a sending host device is entirely different from, and does not disclose or suggest, the claim limitation of normalizing by removing a character from the header.

B. Claims 31-32 and 40-42

In regards to claims 31-32 and 40-42, on page 6 of the Office Action, the Examiner appears to interpret Donaldson's teaching of a "newline" character at the end of a sequence of ASCII characters to read on the claim limitation of the Received line (see col. 2, lines 49-61 and col. 3, lines 5-14). A "newline" character is entirely unrelated to the claim limitation of locating a Received line. The term "Received line" has specific meaning in the field of email messaging and generally refers to a "Received" header keyword and associated data (see paragraphs 36-38 of the Specification), which meaning is unrelated to an ASCII "newline" character. Nevertheless, even if Donaldson taught a Received line as asserted by the Examiner (and it doesn't), Donaldson still does not teach or suggest the claim limitation of locating the Received line as recited in claims 31 and 40, much less validating a source IP address from the Received line as recited in claims 32, 41 and 42.

C. Claims 33 and 43

With respect to claims 33 and 43, the Examiner cites Donaldson's teaching of using angle brackets to enclose a sender's email address (Fig. 3; col. 3, lines 39-41; and col. 4, lines 15-21). This teaching of Donaldson relates to a process for connecting a sending Message Transfer Agent (MTA) to a receiving mail server. This is entirely different from locating delimiters in the Received lines as recited in claims 33 and 43. Further, the Donaldson reference teaches away from the Examiner's interpretation of angle brackets by explicitly stating that the angled brackets shown in Fig. 3 "do not form a part of the message being transmitted" (see col. 4, lines 22-23).

D. Claims 34 and 44

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In regards to claims 34 and 44, the Examiner cites col. 7, lines 31-64 of Donaldson. This portion of Donaldson merely recites seven categories of known solutions for blocking junk email messages and has nothing to do with categorizing the complaint to determine an action based on the category of the complaint as recited in claims 34 and 44.

E. Donaldson and Miloslavsky teach away from the modification suggested by the Examiner

In addition to the requirement that every claim limitation is taught or suggested by prior art references, a *prima facie* case of obviousness also requires: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the reference teachings; and (2) a reasonable expectation of success (see MPEP 2143). The modification of Miloslavsky suggested by the Examiner on page 5 of the Office Action would not have been obvious to one of ordinary skill in the art because Miloslavsky and Donaldson teach away from the suggested modification. Donaldson is directed to filtering junk email by rejecting email from unknown hosts. In contrast to the blocking of emails, Miloslavsky is directed to methods for efficiently routing email messages. Therefore, the modification suggested by the Examiner would tend to contradict the purpose of Miloslavsky. In short, Miloslavsky and Donaldson seek to solve different problems, and there is no reasonable expectation of success for the modification suggested by the Examiner. Therefore, in addition to not establishing a *prima facie* case of obviousness because all claim limitations are not disclosed or suggested as earlier discussed above, the Office Action also fails to establish a *prima facie* case of obviousness against claims 28-34, 38-44, 49, and 50 for the reasons expressed in this paragraph.

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(PATENT)**CONCLUSION**

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 07-2347. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged to such deposit account.

Respectfully submitted,

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